

Application No.: 09/176,639
Reply Brief

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Richard Robert SCHEDIWY	Group Art Unit: 2675
Serial No.: 09/176,639	Examiner: Srilakshmi K. KUMAR
Filed: October 20, 1998	Confirmation No.: 2112

For: FINGER/STYLUS TOUCH PAD

Customer No.: 69819

Attorney Docket No.: 028.1108

REPLY BRIEF SUBMITTED UNDER 37 C.F.R. § 41.41

I. Examiner's response regarding rejections under 35 USC §112, first paragraph, as failing to comply with the written description requirement

In the Examiner's Answer mailed on June 28, 2010, the Examiner alleged that the specification "makes mere conclusionary statements with regards to the appropriate 'moderate' conductivity as opposed to describing how the proper conductivity is achieved in the touch layer". Appellant again submits that the Examiner's argument is more suitable to a rejection for lack of enablement than for failure to meet the written description requirement.

Specifically, appellant again submits that to satisfy the written description requirement, a patent specification must simply describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would

recognize that the inventor had possession of the claimed invention. See, e.g., *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). And again, there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed.

As was described in Appellant's brief, the specification clearly provides a description of a "conductive touch layer", including a specific description of conductive carbon powder in a plastic carrier material as a suitable material. See page 9, lines 1-13 of Appellant's specification. The specification also describes the conductivity of the surface can be chosen for best operation such that the image of the stylus is about the same size as a finger would be on a normal capacitive sensor. See page 10, lines 3-6 of Appellant's specification. As such, a person skilled in the art would clearly recognize that the inventor had possession of the claimed "conductive touch layer" having a conductivity configured to "create an image of said conductive object that is larger than an area of contact of said conductive object".

II. Examiner's response regarding rejections under 35 USC §112, first paragraph, as failing to comply with the enablement requirement

In the Examiner's Answer mailed on June 28, 2010, the Examiner alleged that "The specification requires trial and error/undue experimentation to achieve a touch layer that provides moderate conductivity in order to create a larger image". Appellant again submits that the claims meet the enablement requirements of 35 U.S.C. 112, first paragraph.

Appellant again notes that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is "undue". See *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976), and MPEP 2164.01. In the Answer, the Examiner appears to only allege "undue" experimentation by stating that "the specification does not describe how much carbon powder is required for moderate conductivity" and that to determine "a moderately conductive carbon powder in an epoxy would require undue experimentation".

Appellant again disagrees, and again notes that a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), and MPEP 2164.06.

In the current case, appellants again submit that the specification provides sufficient guidance making a conductive touch layer such “undue experimentation” would not be required by one of ordinary skill in art to make and use the invention.

Specifically, as was described in appellant’s brief, the specification clearly teaches one of ordinary skill in the art is to start with carbon powder impregnated epoxy, which inherently has a moderate conductivity, and adjust the level of conductivity until the desired result is achieved for the particular application. Furthermore, the specification describes a specific example, where the conductivity is chosen such that the image of the stylus is about the same size as a finger would be on a normal capacitive sensor (see page 10, lines 3-6, and the similarity between graph 205 of FIG. 2 and graph 506 if FIG. 6). While determining the precise carbon powder doping needed for such a desired conductivity in a particular application would clearly involve some experimentation, such experimentation would clearly be within the highly technical abilities of one of ordinary skill in the relevant art, and given the explicit guidance in selecting a suitable material and conductivity, such experimentation would not be “undue”.

Again, as stated by the Federal Circuit, “[w]here the specification provides ‘guidance in selecting the operating parameters that would yield the claimed result,’ it is fair to conclude that the experimentation required to make a particular embodiment is not ‘undue’” *PPG Indus v. Guardian Indus Corp.*, 75 F.3d. 1558, 37 USPQ2d 1618 at 1624 (Fed. Cir. 1996), quoting *In re Colianni*, 561 F.2d 220, 224, 195 USPQ 150, 153 (C.C.P.A. 1977) (Miller, J. concurring)

Application No.: 09/176,639
Reply Brief

CONCLUSION

In view of the foregoing, it is believed that all claims now pending are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Board believes that a telephone conference would be useful in moving the application forward to allowance, the Board is encouraged to contact the undersigned at (480) 385-5060 or jpitts@ifllaw.com

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 50-2091 for any fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,
INGRASSIA, FISHER & LORENZ

Dated: August 26, 2010

/S. JARED PITTS/
S. Jared Pitts
Registration No. 38,579
Customer No. 69819